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IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

APPLE INC., <i>et al.</i>)	Case No.: 5:20-cv-06128-EJD
)	
Plaintiffs,)	Defendant's Response to Plaintiffs' Notice of
)	Supplemental Authority
v.)	
)	Hon. Edward J. Davila
ANDREW HIRSHFELD,)	
Performing the Functions and Duties of the)	Date: Under Submission
Under Secretary of Commerce for Intellectual)	
Property and Director of the United States)	
Patent and Trademark Office,)	
)	
Defendant.)	

1 Plaintiffs have submitted the Federal Circuit’s recent decision in *In re Vivint, Inc.*, No.
 2 20-1992 (Sept. 29, 2021) (slip op.), as supplemental authority. ECF No. 128. However, the
 3 reasoning of *Vivint* is inapplicable to this case. Indeed, applying that reasoning here, as Plaintiffs
 4 suggest, would run directly contrary to controlling Supreme Court precedent.

5 *Vivint* concerns the availability of judicial review over decisions made by the Director of
 6 the U.S. Patent and Trademark Office (“USPTO”) pursuant to 35 U.S.C. § 325(d), which is not a
 7 statute at issue in this litigation. Section 325(d) provides that, “[i]n determining whether to
 8 institute or order a proceeding[,] . . . the Director may take into account whether, and reject the
 9 petition or request because, the same or substantially the same prior art or arguments previously
 10 were presented to the” USPTO. *Id.* In *Vivint*, the USPTO argued that such “decisions are
 11 committed to agency discretion based on that statute’s permissive language,” meaning that 5
 12 U.S.C. § 701(a)(2) precludes their review under the Administrative Procedure Act (“APA”). *In*
 13 *re Vivint*, No. 20-1192, at 2. The Federal Circuit rejected that argument, reasoning that
 14 § 325(d)’s “permissive language, alone, does not render [the] question committed to agency
 15 discretion.” *Id.*

16 There is no merit to Plaintiffs’ suggestion that the Federal Circuit’s reading of § 325(d) in
 17 *Vivint* should lead this Court to interpret the statute at issue in this case, 35 U.S.C. § 314(a), to
 18 permit judicial review of Plaintiffs’ claims. Indeed, as Defendant noted in his argument that the
 19 Director’s actions taken pursuant to § 314(a) are committed to agency discretion by law,
 20 § 325(d) “specif[ies] the factors that the Director should take into account when making the
 21 institution decision,” whereas “[t]he absence of any such limits in § 314(a) . . . confirms the
 22 Director’s discretion to consider any relevant factor in deciding whether to deny institution.”
 23 ECF No. 91 at 7 n.5.

24 Moreover, the cited language in *Vivint* is inapplicable here because Defendant did not
 25 rely on § 314(a)’s “permissive language[] alone” to argue that Plaintiff’s claims are not subject
 26 to judicial review. *In re Vivint*, No. 20-1192, at 2. Rather, Defendant also relied on (1) the plain
 27 language of 35 U.S.C. § 314(d), which expressly states that the Director’s institution decision

1 “shall be final and nonappealable,” (2) the overall statutory scheme of the America Invents Act
 2 in light of APA case law, and (3) Supreme Court precedent explicitly holding that the Director’s
 3 decisions pursuant to § 314(a) are “committed to . . . [his] discretion” under 5 U.S.C. § 701(a)(2),
 4 *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, ___, 136 S. Ct. 2131, 2140 (2016). ECF No. 64
 5 at 10-15.

6 Finally, Plaintiffs’ claim that *Vivint* implies that “the standards governing decisions under
 7 § 314(a)” “are not committed to [the Director’s] unreviewable discretion” because of § 314(a)’s
 8 statutory language runs directly contrary to the holding in *Cuozzo*. ECF No. 128 at 2. There, the
 9 Supreme Court explicitly stated that the AIA includes “no mandate to institute review” and that
 10 § 314(a) “committed [the *inter partes* review institution decision] to the Patent Office’s
 11 discretion.” *Cuozzo Speed Techs.*, 579 U.S. at ___, 136 S. Ct. at 2140 (citing 5 U.S.C.
 12 § 701(a)(2)); *see also Mylan Labs. Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1382
 13 (Fed. Cir. 2021). This Court therefore should not accept Plaintiffs’ contention that the language
 14 of § 314(a) permits judicial review of the Director’s exercise of his authority under that statute.
 15

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on October 8, 2021, I electronically filed the foregoing document with the Clerk of the Court, using the CM/ECF system, which will send notification of such filing to the counsel of record in this matter who are registered on the CM/ECF system.

Executed on October 8, 2021, in Washington, D.C.

/s/ Gary Feldon
GARY D. FELDON